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EXAMINER

FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/841,038	Applicant(s) MORITA, FUJIO	
	Examiner JEAN B. FLEURANTIN	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-12 remain pending for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 21 July 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner (see PTO - 1449).

Response to Applicant's Remarks

3. Applicant's arguments filed 7 September 2004 have been fully considered but they are not persuasive for the following reasons: In response to applicant's argument on page 10, that "Applicant has amended Claim 12 to recite, in relevant part, "searching for the address of the desired information based on the registered predetermined search information when a category is selected." However, it is unclear that the support on page 17, lines 20-34 of the specification does not explicitly reflect the newly added limitations.

In response to applicant's argument on page 11, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the creation of a simplified network address in an understandable form) are not recited in the rejected claim(s). Although the claims are interpreted in light

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of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In view of the above, the Examiner contends that all limitations as recited in the claims have been addressed in this action.

Claims 1, 3, 4, 8, 9, 10 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As recited the newly added limitations "said predetermined search information comprising a specific word in a general language".

In response to applicant's argument on page 11, that Osaku fails to teach or suggest "predetermined search information comprises a specific word in a general language." It is submitted that Related Art and Osaku disclose the claimed subject matter except the claimed a specific word in a general language. However, Mahajan discloses the claimed the language model can be a specific subject matter or simply a general language model (see Mahajan col. 7, lines 45-55). Further, in column 8, lines 16-49, Mahajan discloses based upon the information retrieved from general data store as a result of the query being executed against general data store. It would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Related Art and Osaku and Mahajan with a specific word in a general language. Such modification would allow the teachings of Related Art and Osaku and Mahajan to

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provide results in better performance of the information retrieval system (see Mahajan col. 15, lines 15-16).

In response to applicant's arguments on page 11, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

MPEP 2111 Claim Interpretation: Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

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The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Related Art (hereinafter "Related Art") in view of U.S. Patent No. 6,061,738 issued to Osaku (hereinafter "Osaku") and further in view of U.S. Patent No. 6,418,431 issued to Mahajan et al. (hereinafter "Mahajan").

As per claim 1, Related Art discloses, "a search unit that determines a category of an address designated for registration based on a definition entry and a selection record of a menu" (see figure 1, page 2, lines 26-32); and "a registration unit that registers an address in the category", (see figure 1, element S 16, page 3, line 30 to page 4, line 1),

"wherein predefined search information is registered for each category", (see page 4, lines 31-34). Related Art does not explicitly disclose a search support device in which an address indicating a location of information accessible on a network is

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registered, and predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network. However, Osaku discloses when a simplified network address is input to the client for a network accessible resource is first passed to the client search engine which uses the simplified network address as a search key for searching the selected correspondence relations located on the client cache, if a correspondence relation matching the key is located on the cache, in which the client search engine returns a corresponding URL, which in the present example we assume is URL2. Having found a corresponding URL within the client cache, the client uses the URL2 to form a network access command <http://LTRL2/> which is addressed to a network resource having a copy of a network file corresponding to the simplified network address input by the user, (see Osaku Col. 9, lines 20-39), and column 8, lines 39-58. It would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Related Art and Osaku. Such modification would allow the teachings of Related Art and Osaku to provide novel methods and systems for accessing a network URL through pre-assigned simplified network addresses, (see Osaku Col. 1, line 66 to Col. 2, line 1). While, Related Art and Osaku disclose the claimed subject matter except the claimed a specific word in a general language. However, Mahajan discloses the claimed the language model can be a specific subject matter or simply a general language model (see Mahajan col. 7, lines 45-55). Further, in column 8, lines 16-49, Mahajan discloses based upon the information retrieved from general data store as a result of the query being executed against general data store. It would have been obvious to a person of ordinary skill in

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the art to modify the combined teachings of Related Art and Osaku and Mahajan with a specific word in a general language. Such modification would allow the teachings of Related Art and Osaku and Mahajan to provide results in better performance of the information retrieval system (see Mahajan col. 15, lines 15-16).

As per claim 2, Related Art discloses, "wherein the registration unit registers the address designated for registration in the category containing the registered address the registered address when located at the same level as the address designated for registration", (see page 4, lines 15-19).

As per claim 3, in addition to claim 1, Related Art discloses, "determining a category of an address designated for registration based on a definition entry and a selection record of a menu", (see page 4, line 11 to page S, line 2).

As per claim 4, in addition to claim 1, Related Art discloses, "a category menu storage unit that stores a category menu in which predetermined categories are listed up" as the information including the URL address of each registered homepage is registered as the list of registered bookmarks, (see figure 3, page 4, lines 15-19).

As per claim 5, in addition to claims 1 and 3, Related Art further discloses, "a display unit that displays an address in another form indicating the location of desired

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information detected based on the search information generated by the search information generating unit", (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 6, Related Art further discloses, "an address selection unit that selects the address registered in the category menu so as to make an access to the location of the desired information", (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 7, Related Art discloses, "an icon conversion unit that visually changes the category in which the address is registered by the address registration unit" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 8, in addition to claim 1, Related Art discloses, "storing a category menu in which predetermined categories are listed up" as the information including the URL address of each registered homepage is registered as the list of registered bookmarks, (see figure 3, page 4, lines 15-19).

As per claim 9, in addition to claim 1, Related Art discloses, "a procedure for classifying the address in accordance with a category related to information that can be accessed at the address", (see page 4, line 11 to page 5, line 2); and

"a procedure for registering the address classified in accordance with the category", (see figure 1, element S16, page 3, line 30 to page 4, line 1).

As per claim 10, in addition to claim 1, Related Art discloses, "a procedure for generating search information associated with a category selected from the category menu" as the information including the URL address of each registered homepage is registered as the list of registered bookmarks, (see figure 3, page 4, lines 15-19); and "a procedure for registering the address classified in accordance with the category", (see figure 1, element S16, page 3, line 30 to page 4, line 1).

As per claim 11, Related Art discloses, "wherein the program further includes a procedure for generating the category menu", (see figure 3(A, B).

As per claim 12, in addition to claim 1, Osaku further discloses, "a method for searching for an address of desired information on a network based on search information associated with the desired information", (see col. 8, lines 40-47), the method comprising:

"registering predetermined search information (see fig. 14, elements 292, 294, 296) used as a keyword for searching for the address of the desired information on the network for each of a plurality of categories into which information is classified" as simplified network address is input to the client for a network accessible resource is first passed to the client search engine which uses the simplified network address as a search key for searching the selected correspondence relations located on the client cache, if a correspondence relation matching the key is located on the cache, in which

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the client search engine returns a corresponding URL, which in the present example we assume is URL2. Having found a corresponding URL within the client cache, the client uses the URL2 to form a network access command <http://URL2/> which is addressed to a network resource having a copy of a network file corresponding to the simplified network address input by the user, (see Osaku col. 9, lines 20-39), and column 8, line 39-58.

"searching for the address of the desired information based on the registered predefined search information when a category is selected", (see page 4, line 23 to page 5, line 2).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

February 4, 2005


SHAHID ALAM
PRIMARY EXAMINER